

REMARKS/ARGUMENTS

Upon entry of this amendment, claims 1-10 and 12-17 are pending in this application and presented for examination. Claim 11 has been canceled without prejudice or disclaimer. Claim 4 has been amended. Claims 12-17 are newly added. No new matter has been introduced with the foregoing amendments. Reconsideration is respectfully requested.

I. FORMALITIES

Applicants note that the Supplemental Information Disclosure Statement filed on July 30, 2003 has not been acknowledged by the Examiner. Applicants respectfully request that the Examiner initial the form PTO/SB/08B submitted with the Supplemental Information Disclosure Statement on July 30, 2003. For the Examiner's convenience, a copy of the same is enclosed.

Claim 4 has been amended to correct a typographical error. Claims 12-17 are newly added. Support for new claims 12 and 13 is found, for example, on page 6, lines 17-21. Support for new claim 14 is found, for example, on page 4, line 13. Support for new claim 15 is found, for example, on page 3, lines 17-19. Support for new claim 16 is found, for example, on page 4, lines 25-28; and page 6, line 24. Support for new claim 17 is found, for example, on page 6, lines 11-14 and on page 3, lines 30-31. Thus, no new matter has been introduced. As such, Applicants respectfully request that the amendments to the claims and the new claims be entered.

Example 1 in the specification has been amended to correct a typographical error. Support for the amendment is found for example, on page 14, line 17. Thus, no new matter has been introduced. As such, Applicants respectfully request that the amendment to the specification be entered.

II. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 6 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicants regard as their invention. In particular, the Examiner alleges that the recitation of "molecular weight" is indefinite. In response, Applicants respectfully traverse the rejection.

As set forth in MPEP § 2173.02:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Applicants assert that the term "molecular weight" is definite in view of both the teachings of the prior art and the claim interpretation that would be given by one of ordinary level of skill in the art at the time the invention was made. For example, U.S. Patent No. 5, 866,152¹ ("Takebayashi *et al.*") teaches on column 2, lines 18-21, that "when polyethylene glycol is used as the polyhydric alcohol, the ***weight average molecular weight*** of the polyethylene glycol is preferably 300 to 6000" (emphasis added). Further, one of ordinary skill in the art at the time the present invention was made would have appreciated that the number following a particular polyethylene glycol (*e.g.*, polyethylene glycol 400 (PEG 400)) refers to the weight average molecular weight of the polyethylene glycol (*e.g.*, the "400" in PEG 400 refers to the weight average of molecular weights from 380-420). As such, one of ordinary skill in the art would have understood that the "polyethylene glycol of a molecular weight of 200-800" as set forth in claim 6 refers to the weight average molecular weight of the polyethylene glycol. Therefore, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 112, second paragraph rejection.

¹ The Examiner cited U.S. Patent No. 5, 866,152 in Section III below.

III. REJECTION UNDER 35 U.S.C. § 102(b)

Claims 1, 4-8, and 10 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Takebayashi *et al.* To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

In response, Applicants assert that in no instance does Takebayashi *et al.* teach a substantially *non-aqueous* liquid shampoo compositions as is presently taught and claimed.

As the Examiner is well aware, in order to anticipate a claim, each and every element of the claim must be disclosed in the prior art reference. As set forth in MPEP § 2131:

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (*see, Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Takebayashi *et al.* does not disclose a substantially *non-aqueous* liquid shampoo. Rather, Takebayashi *et al.* disclose an *aqueous* shampoo for the control of ectoparasites. In particular, Takebayashi *et al.* teach compositions containing an aqueous surfactant solution and water (*see*, Production Examples 1-5 and 7-9). As a result, in addition to the water present from the surfactant solution (*i.e.*, about 46.7% water from a 30% POE 4 lauryl sulfate triethanolamine solution; about 38.7% water from a 42% lauryl sulfate triethanolamine solution), an additional 19.2% (Production Examples 7 and 8), 23.2% (Production Examples 2, 4, and 5), 27.8% (Production Example 9), and 28.2% (Production Examples 1 and 3) amount of water is added to the compositions to bring the mixture to 100%. Although Production Example 6 does not contain an aqueous surfactant solution, an amount of 69.9% water is added to the composition. Further, Takebayashi *et al.* teach diluting the compositions from 30- to 200-fold with water for more effective, uniform treatment (*see*, col. 3, lines 9-13; Test Examples 1 and 2).

By stark contrast, the substantially *non-aqueous* liquid shampoo compositions of the present invention not only contain less than 20% water based on the total weight of the composition, but the water is present "by virtue of their incorporation of constituents commonly used in shampoos such as surfactants which may contain a proportion of water" (*see*, page 3, lines 12-21). Thus, the invention as is presently taught and claimed refers to substantially *non-*

aqueous liquid shampoo compositions where: (1) constituents such as surfactants contribute minimally to water content; (2) no additional water is added; and (3) no dilution with water is performed. As each and every element is not disclosed in the prior art reference, it does not anticipate the present claims. Accordingly, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(b) rejection.

IV. REJECTION UNDER 35 U.S.C. § 103(a)

Claims 2,3, and 9 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of Takebayashi *et al.* and WO 87/04617 ("Moberg") and U.S. Patent 6,207,694 ("Murad"). To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

As set forth in M.P.E.P. § 2143:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

All three elements set forth above must be present in order to establish a *prima facie* case of obviousness. However, Applicants assert that a *prima facie* case of obviousness has not been established for the following reasons: 1) there is no suggestion or motivation to modify the references; 2) there is no reasonable expectation of success; and 3) the cited references do not teach or suggest all the claim limitations.

Applicants assert that there is simply no motivation or suggestion provided in the cited references to modify their teachings in the way the Examiner has contemplated. As discussed above, Takebayashi *et al.* teach *aqueous* shampoo compositions containing an aqueous surfactant solution and water for the control of ectoparasites. Murad teaches *aqueous* shampoo

compositions for dandruff (Examples 1 and 4), thinning hair (Examples 2 and 5), and chemically treated hair (Example 3) containing from 47% to 86.4% of added water. However, neither reference teaches or suggests the substantially *non-aqueous* liquid shampoo compositions of the present invention. Moberg teaches liquid compositions containing a combination of urea, lactic acid, and high amounts of propylene glycol (*see*, page 3, lines 10-21). However, Moberg does not teach or suggest the use of high amounts of propylene glycol in *non-aqueous* liquid **shampoo** compositions. As such, there would have been no suggestion or motivation to modify the teachings of Takebayashi *et al.*, Murad, and Moberg, alone or in combination, to arrive at the substantially *non-aqueous* liquid **shampoo** compositions of the present invention.

Further, Applicants assert that there is absolutely no reasonable expectation that the compositions of the present invention would be successful based on the combined teachings of Takebayashi *et al.*, Murad, and Moberg. These cited references, alone or in combination, do not teach or suggest substantially *non-aqueous* liquid **shampoo** compositions would be useful. Advantageously, the claimed compositions provide cosmetically and aesthetically acceptable shampoos having acceptable foaming characteristics (*see*, page 3, lines 7-11).

Finally, Applicants assert that the cited references, either alone or in combination, do not teach or suggest all the limitations of the claims. As discussed above, the present invention teaches substantially *non-aqueous* liquid **shampoo** compositions. None of the references, alone or in combination, teach or suggest such compositions. Again, Takebayashi *et al.* and Murad only teach *aqueous* shampoo compositions and Moberg only teaches liquid, **non-shampoo** compositions containing a combination of urea, lactic acid, and high amounts of propylene glycol. Therefore, the Examiner has failed to present a *prima facie* case of obviousness. As such, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) rejection.

Appl. No. 10/069,448
Amdt. dated March 30, 2004
Reply to Office Action of November 4, 2003

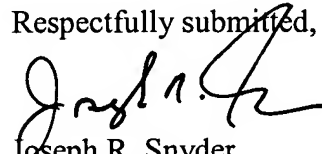
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V. CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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